REMARKS

This is in response to the Office Action that was mailed on June 26, 2006. Claims 24-28, 33-36, and 38-40 are cancelled, without prejudice. Formal amendments to the remaining claims address issues raised by the Examiner in the Office Action. No new matter is introduced by this Amendment. With this Amendment, claims 29-32, 37, and 41 remain in the application.

As required by the Examiner, a new Abstract of the Disclosure is provided.

The objections to claim 41 are obviated by the above amendment of claim 41.

Claims 31-41 were rejected under the first paragraph of 35 U.S.C. § 112 as allegedly failing to comply with the enablement requirement. Office Action, pages 3-10. Applicants respectfully submit that the reduced scope of the claims remaining in this application is clearly enabled by the extensive disclosure provided by Applicants' specification to persons skilled in the relevant art.

Claims 29-40 were rejected under the second paragraph of 35 U.S.C. § 112 as failing to define the invention properly. The specific issues raised by the Examiner in this regard at the top of page 11 of the specification are obviated by the present amendment of the claims.

Claims 2-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0 477,819 A2 and EP 0 617,023 A1. Office Action, pages 13-15. It is noted that both of these

references are assigned to the Assignee of the present application, NeuroSearch A/S. The rejections are respectfully traversed.

Applicants point out that the compound of Example 6 in EP 0 617 023 A1 is the same as the compound designated NS1619 in e.g. WO 01/54711. Properties of this prior art compound are compared to analogous properties of the compound of present claim 29 in Examples 2 and 3 of the present specification. The comparative showings in the specification should be taken as obviating at least the rejection over EP 0 617 023 A1.

The Examiner has, however, requested that Applicants compare the compound of Example 10 in EP 0 477 819 A2. Accordingly, Applicants have compared that compound – 1-(5-chloro-2-hydroxyphenyl)-5-fluoro-1,3-dihydro-2H-benzimidazol-2-one – with the compound of present claim 29 – 1-(5-chloro-2-hydroxyphenyl)-5-chloro-1,3-dihydro-2H-benzimidazo-2-one. These two compounds were compared in a standard electrophysiological assay – specifically, screening on *Xenopus leavis* oocytes over-expressing human BK channels. The result of this comparison is presented in enclosed Exhibit A, in which the reference compound is referred to as "Compound A" and the presently claimed compound is referred to as "Compound B". Compound B (the present invention) provides an unexpectedly higher level of activity (as evidenced by % current increase) than does reference Compound A. This dramatic difference in properties clearly rebuts any *prima facie* case of obviousness raised by structural similarity. Accordingly, withdrawal of the rejection over EP 0 477 819 A2 is likewise in order and is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No.

28,781) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By R. Lloyd #28,781

GMM/RG

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